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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,975	05/02/2006	Stuart Cook Niven	11/2-22976/A/MA 2236/PCT	7546
324	7590	12/24/2008	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			FAISON GEE, VERONICA FAYE	
			ART UNIT	PAPER NUMBER
			1793	
			MAIL DATE	DELIVERY MODE
			12/24/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,975	<b>Applicant(s)</b> NIVEN ET AL.	
	<b>Examiner</b> VERONICA FAISON GEE	<b>Art Unit</b> 1793	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-12 and 14-22 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-12 and 14-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-7-06</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-12 and 14-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryter (US 2007/0041479).

Ryter teaches oil-based lithographic printing ink as colorant a mixture of an organic pigment and an organic dyestuff soluble in an organic solvent (solvent dye). (abstract). The reference further teaches specific solvent dyes that may be present in the composition including Solvents Reds 19, 23,24, 25, 26, 27, and 29, Solvent Blues 14, 35, 36, 59, and 78, Solvent Yellows 7,14, 33, 72, 94, and 114, Solvent Oranges 1, 2, and 7 (0021-0026). The reference teaches a pigment/solvent dye ratios comprise in the range of (99-1): (1-99) (0028). The ink may contain 0.1 to 70% by weight of pigment/solvent dye composition, the remainder being customary printing ink-varnishes (ink-vehicles), solvents and other suitable and well known additives. The 0.1 to 70% range covers concentrated and ready-to-use printing inks (0029). The reference further teaches that the composition may be prepared by surface treating (coating) the organic

Art Unit: 1793

pigment with a varnish (ink vehicle) or varnish component, solvent and other customary additives, the vehicle(s) (components) or additives being mixed or colored with the solvent dye either prior or during processing. The solvent dye may be present in dispersed or dissolved form (0036). The process for preparing these lithographic printing ink colorants comprises incorporating the printing ink varnish, which is premixed or colored with the solvent dye, into an aqueous slurry of the organic pigment, isolation, and optionally drying it or adding the printing ink varnish to an aqueous slurry of the solvent dye and then combining it with an aqueous slurry of the organic pigment, isolating, and optionally drying it or adding the printing ink varnish to an aqueous slurry of a solvent dye/organic pigment combination, isolating, and optionally drying it (0037). Printing inks among other components, e.g. high boiling distillates and/or vegetable oils, high wetting alkyd resins plus highly structured alkyd resins and vegetable resins, and mixtures thereof; further monomers/oligomers/polymers that can be cured by UV-radiation can also be used (0038). The oil based printing inks for lithographic printing systems can be prepared by incorporating the pigment into the printing ink varnish by a variety of shear rate-inducing methods, such as mixing, bead-milling, triple-roll milling, kneading, and extrusion; alternatively, heat-inducing methods can also be used (0048). The dyestuff can be dissolved into the varnish by any method allowing the application of heat (0050). The preferred method of incorporation would be extrusion. In an ink vehicle (or molten ink vehicle resin) passed through such as apparatus, dispersion of the pigment (by high shear) and solution of the dye (by heat generation) can be achieved either simultaneously or sequentially (0053). The pigment may be applied as

Art Unit: 1793

either a damp press-cake, dry lump, granule or powder (0054). The varnish can be premixed or colored with the solvent dye and then added to an aqueous pigment slurry. Alternatively, the varnish can be added to an aqueous slurry of the solvent dye or a mixed slurry of the pigment and solvent dye (0055). The composition as taught by Ryter appears to anticipate the claimed invention.

Claims 1, 2, 8, 11, 12, 14, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mehta et al (US Patent 5,944,881).

Mehta teaches ink colored dye, a colored pigment, and a fluorescent pigment (abstract). Ink is provided comprising a colored pigment, a fluorescent pigment, a colored dye, and a liquid carrier acts as a solvent for the dye (col. 1 line 67- col. 2 line 3). The liquid carrier comprises a blend of aliphatic long chain oil and a long chain unsaturated fatty acid wherein some of the preferred aliphatic oils include soybean oil and peanut oil (col. 2 lines 11-14). Soybean oil is most preferred. The long chain oil component preferably makes up from about 5 to about 40% by weight of the ink. The ink also preferably includes from about 4 to 10% by weight of a thickener (col. 3 lines 48-64). The ink is printed onto a security document by a letterpress printing process (col. 4 lines 1-2). Security ink was prepared by combining the following material: the red base dye was dissolved into the linoleic acid by mixing for thirty minutes at 100°C. The fluorescent base, soybean oil, and black base were then added to the mixture. The temperature was then raised to 120°C., and the thickener was added. The components were mixed for forty minutes at 120°C and then drained into container (col. 4 lines 45-

Art Unit: 1793

col. 5 line1). The composition as taught by Mehta appears to anticipate the claimed invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERONICA FAISON GEE whose telephone number is (571)272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/

Supervisory Patent Examiner, Art Unit 1793

/V. F. G./

Examiner, Art Unit 1793

Application/Control Number: 10/577,975  
Art Unit: 1793

Page 6